

Independent claims 1, 8, 13 and 20 are amended herein to include the limitations of claims 4, 9, 16 and 21, respectively. Claims 4, 9, 16 and 21 are canceled herein.

Consistent with 37 C.F.R. §1.321(b)(1)(IV) and MPEP Section 804.02, a Terminal Disclaimer signed by the below-named attorney of record, along with a Statement under 37 C.F.R. §3.73(b) and requisite fee, were filed on November 20, 1996. In a telephone conference with the Examiner on April 9, 1997, the Examiner indicated that the Terminal Disclaimer filed on November 20, 1996 **is proper** and, thus, it is unnecessary for applicants to submit a Terminal Disclaimer with the Assignees' signatures as indicated in the Office Action under reply (paragraph 1). It is requested that the rejection of claims 1-3, 5-8, 10-15, 17-20 and 22-23 under 35 U.S.C. 101 be withdrawn.

Claims 1-23 have been rejected under 35 U.S.C. § 103 as being unpatentable over Kato (U.S. Patent 5,543,847).

The filing date to which the Kato patent is entitled for the purpose of using it as a reference is December 13, 1993. The instant application is a continuation-in-part of U.S. Patent Application Serial No. 08/219,472, filed March 29, 1994, now U.S. Patent No. 5,473,380, which has a priority filing date of March 29, 1993, the date on which Japanese priority application 05-069,829 was filed. A certified copy of Japanese priority application 05-069,829 was filed on March 29, 1994 in the parent

application, and a sworn English translation of this priority application is enclosed herewith.

It is submitted that Japanese priority application 05-069,829, filed March 29, 1993, effectively antedates the Kato patent because the Japanese priority application discloses that subject matter currently being claimed in the present application which the Examiner is asserting is disclosed in Kato. In other words, both the parent U.S. application (Serial No. 08/219,472) and its Japanese priority application disclose all of the features recited in claims 1-23 of the present application (claims 4, 9, 16 and 21 now canceled), except the limitation that the picture type data identifies an encoding structure of a group of pictures represented by the digital picture signal, as recited in claims 1, 8, 13 and 20 (previously recited in claims 4, 9, 16 and 21); and Kato **does not** disclose this particular feature (to be further discussed). That is, Kato does **not** disclose the particular claimed features that are not supported in the parent application and its Japanese priority application.

The CCPA court in In re Stempel, 241 F.2d 755, 760 (CCPA 1957), held:

"In the case of a reference, it is fundamental that it is valid only for what it discloses and if the applicant establishes priority with respect to that disclosure, and there is no statutory bar, it is of no effect at all."

While the date of prior application in Stempel was established by affidavits, the CCPA court in In re Ziegler, 347 F.2d 642, 550 (CCPA 1965), held that the holding in Stempel also applied where priority is established by foreign applications and, thus, a reference is invalid if the earlier priority application of applicant discloses all of the matter of the reference that is relied upon to reject the claims.

In the Office Action under reply, the Examiner asserted that "the picture type data [of Kato] identifies an encoding structure of a group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures." (Office Action, page 6, lines 10-13). Contrary to the Examiner's assertion, the "picture type" data of Kato does not identify the encoding structure of the GOP. Based on a careful reading of Kato, it is submitted that Kato discloses that the video signal includes, in addition to the picture information, a GOP header for enabling random accessing which includes therein a particular flag, neither of which identifies the encoding structure of the GOP. As discussed at col. 1, lines 39-55, col. 3, lines 63-67, col. 7, line 52 to col. 8, line 6 and col. 8, lines 22-30, a GOP start code of the GOP header is detected to identify the beginning of the GOP, and a random accessibility indicating flag in the GOP header is detected to determine whether a P-picture of the GOP has been encoded using a decoded picture belonging to a past GOP. Thus,

Kato does not disclose picture type data that identifies an encoding structure of the **GOP** and, further, although not necessary to invalidate Kato, Kato does not disclose picture type data that identifies the type of encoding of **each** picture of the **GOP**.

Therefore, since the parent U.S. application of the instant application has an effective priority filing date that antedates the December 13, 1993 U.S. filing date of Kato, and the parent application discloses that subject matter currently being claimed in the present application which the Examiner is asserting is disclosed in Kato, this patent is not available as "prior art" to reject the claims of the present application. It is requested that the rejection of claims 1-3, 5-8, 10-15, 17-20 and 22-23 be withdrawn.

Even if Kato is considered a valid prior art reference, it is submitted that Kato neither discloses nor suggests that its picture type data (e.g., the **GOP** header data) identifies the encoding structure of the **GOP** and further identifies the type of encoding of **each** picture of the **GOP**, as now recited in independent claims 1, 8, 13 and 20 (and previously recited in now-canceled claims 4, 9, 16 and 21), for those reasons previously discussed.

Further, Kato neither discloses nor suggests that it receive a digital picture signal with picture type data that indicates the type of encoding **to be used to code each of the**

pictures of the GOP, as recited in claims 1 and 13. Still further, Kato neither discloses nor suggests that it add to the decoded digital picture signal picture type data that indicates the previous type of encoding of each picture of the GOP, as recited in claims 8 and 20. Kato, instead, discloses that a flag be added to each GOP that provides encoding information for only P-pictures, not every picture of the GOP.

In view of the foregoing discussion, it is respectfully submitted that Kato is an invalid reference to reject claims 1, 8, 13 and 20 and, further, that claims 1, 8, 13 and 20 are patentably distinct and unobvious over Kato. It is requested that the rejection of claims 1, 8, 13 and 20 be withdrawn.

Since claims 2, 3 and 5-7 depend from claim 1, claims 10-12 depend from claim 8, claims 14, 15 and 17-19 depend from claim 13, and claims 22-23 depend from claim 20, the foregoing discussion of claims 1, 8, 13 and 20 is equally applicable to claims 2, 3, 5-7, 10-12, 14-15, 17-19 and 22-23 and is believed to obviate the rejection of claims 2, 3, 5-7, 10-12, 14-15, 17-19 and 22-23.

New claims 24, 26, 28 and 30 depend from claims 1, 8, 13 and 20, respectively, and state that the digital picture signal includes an ancillary area in which the picture type data is included followed by a video area in which picture data which represents a picture of the digital picture signal is included. Support for the recitations of claims 24, 26, 28 and 30 is set

forth at page 43, lines 9-20 of the specification and Figs. 17A-17C of the drawings. The allowance of claims 24, 26, 28 and 30 is solicited.

New claims 25, 27, 29 and 31 depend from claims 1, 8, 13 and 20, respectively, and state that the picture type data identifies the minimum number of frames between two frames that are encoded by either intrapicture (I-frames) or predictive coding (P-frames) and also identifies the total number of frames in the group of pictures that is represented by the digital picture signal. Support for the recitations of claims 25, 27, 29 and 31 is set forth at page 44, lines 5-21 of the specification. It is noted that Kato does not disclose picture type data that identifies this information. The allowance of claims 25, 27, 29 and 31 is solicited.

Statements appearing above in respect of the disclosures in the cited reference represent the present opinions of the applicants' undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

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On the basis of the above amendments and remarks,
reconsideration and allowance of claims 1-3, 5-8, 10-15, 17-20
and 22-31 are respectfully requested.

Respectfully submitted,

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